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KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			PEREZ DAPLE, AARON C	
			ART UNIT	PAPER NUMBER
			2121	

DATE MAILED: 12/10/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/039,747

Applicant(s)

MATSUURA ET AL.

Examiner

Aaron C Perez-Daple

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/09/01.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. This Action is in response to Application filed 11/09/01, which has been fully considered.
2. **Claims 1-12** are presented for examination.

### *Drawings*

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Claims 1, 10 and 12 recite the limitation of "capturing an image." Claim 11 recites "image capture means." Therefore, the image capture device or "means for capturing an image" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. Figure 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

5. The disclosure is objected to because of the following informalities: the controller discussed in the "Construction of Controller" section of the Detailed Description constitutes prior art and should be acknowledged as such. See Sasaki et al (US 6,254,477 B1), Fig. 7.

Appropriate correction is required.

***Claim Objections***

6. **Claim 7** is objected to because of the following informalities: line 4 recites “passing the center” where it should recite --passing through the center--. Appropriate correction is required.
7. **Claim 8** is objected to because of the following informalities: line 3 recites “corresponded” where it should recite --corresponding--. Appropriate correction is required.
8. **Claim 9** is objected to because of the following informalities: line 8 recites “corresponded” where it should recite --corresponding--. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. **Claims 2 and 3** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As for claim 2, the limitation of “using fixed parameters” recited in line 4 has not been enabled. As for claim 3, the limitation of “using variable parameters” in line 4 has not been enabled. Pages 9 and 10 of the specification discuss using “fixed” and “variable” parameters in the extraction of images. However, the Examiner finds that the discussion is not sufficient to

enable one of ordinary skill in the art to make and/or use the invention. It is not clear what “parameters” are being fixed or made variable nor how they are being used to control the extraction of images. Because of these deficiencies, and giving “parameters” the broadest reasonable interpretation, the Examiner finds that any known method of image extraction will meet these limitations.

11. **Claim 4** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the limitation “stereographically” recited in line 3 has not been disclosed in the specification. As defined by Miriam-Webster’s Collegiate Dictionary, 10<sup>th</sup> Edition, a stereograph is, “a pair of stereoscopic pictures or a picture composed of two superposed stereoscopic images that gives a three-dimensional effect when viewed with a stereoscope or special spectacles.” Applicant has further not disclosed any special viewing apparatus, such as a stereoscope or special spectacles, required for viewing a stereographic image.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. **Claims 1-12** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 1, 10 and 12 recite the limitation of “capturing an image.” Claim 11 recites “image capture means.” Although the terms “capturing an image” and “image capture means” are not by themselves indefinite, the Examiner finds that

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they are indefinite when taken in context of the specification. Neither the drawings, especially Fig. 1, nor the preferred embodiment as disclosed on page 8 of the specification disclose a conventional image capture device (which would include, for example, a digital camera or a video recorder). In contrast, both the figures and the specification disclose a disk drive for receiving the stored images. It is not clear to the Examiner whether the Applicant intends for the limitations of “capturing an image” and “image capture means” to include receiving an image stored on a computer readable medium, such as a CD-ROM or floppy disc. For the purpose of applying prior art, the Examiner interprets that the limitations of “capturing an image” and “image capture means” include receiving an image stored on a computer readable medium, such as a CD-ROM or floppy disc.

14. As dependent claims, claims 2-9 share the deficiencies of claim 1.
15. **Claim 4** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the limitation “stereographically” recited in line 3 renders the claim indefinite (see rejection under 35 USC 112, first paragraph, above). The specification does not disclose nor enable this feature of the claimed invention. For the purpose of applying prior art, the examiner interprets that any three-dimensional representation of the extracted partial image meets this limitation.
16. **Claim 5** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the limitation “shiningly” recited in line 3 renders the claim

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indefinite. The Examiner interprets that the brightness or color of the extracted partial image is changed in the step of adding the predetermined visual effect.

17. **Claim 9** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the limitation recited in lines 5-6, "to pass the center of the entire image" is not clear and renders the claim indefinite. There are many ways in which the "partial image" could be considered to "pass" the center of the entire image. It is not clear whether the Applicant intends to limit the claim to actually "passing through" the center of the entire image. For the purpose of applying prior art, the Examiner interprets that the "partial image" may simply "pass by" the center of the entire image.

18. **Claims 10 and 12** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claims 10 and 12 recite "wherein the program comprises the steps of" and "a display control program comprising the steps of." The Examiner finds that a program does not comprise steps but, rather, causes steps to be executed. For the purpose of applying prior art, the Examiner interprets that the "program executes the steps comprising."

***Claim Rejections - 35 USC § 101***

19. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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20. **Claim 12** is rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Specifically, the claimed “display control program” constitutes “descriptive material” which is not tangibly embodied. A program may be tangibly embodied when, for example, it is recorded on some computer-readable medium. However, “descriptive material” is nonstatutory when claimed as descriptive material *per se* [see *In re Warmerdam*, 33F.3d at 1360, 31 USPQ2d at 1759].

***Claim Rejections - 35 USC § 102***

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

22. **Claims 1-6 and 10-12** are rejected under 35 U.S.C. 102(b) as being anticipated by Sitrick (US 5,553,864) (hereinafter Sitrick).

23. As for claims 1, 10 and 12, Sitrick discloses a display control method and a storage medium having recorded therein a control program comprising the steps of:

capturing an image [col. 2, lines 50-64, “In accordance with one...system is coupled.”];

extracting a partial image from the captured image [extraction of a partial image is

inherent in the steps of creating sub-images and of separating images from the background,

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as disclosed by Sitrick; col. 7, lines 36-40, "Game display functions...character image, etc.); col. 25, lines 5-16, "Alternatively or additionally...an audiovisual display."];

adding a predetermined visual effect to the extracted partial image [col. 25, lines 17-28, "The user created...of game rules."]; and

displaying the partial image added with the predetermined visual effect in a moving motion [col. 22, lines 23-47, "For video game systems...video display presentation."; col. 25, lines 17-28, "The user created...of game rules."].

24. As for claim 2, Sitrick discloses the display control method according to claim 1, wherein a moving image is captured in the step of capturing the image [col. 1, lines 54-67, "In accordance with...game play and presentation."]; and

the partial image is extracted using fixed parameters in the step of extracting the partial image [col. 7, lines 36-40, "Game display functions...character image, etc.); col. 25, lines 5-16, "Alternatively or additionally...an audiovisual display."].

25. As for claim 3, Sitrick discloses the display method according to claim 1, wherein a still image is captured in the step of capturing the image [col. 2, lines 1-27, "A game image...resulting video game."]; and

the partial image is extracted using variable parameters in the step of extracting the partial image [col. 7, lines 36-40, "Game display functions...character image, etc.); col. 25, lines 5-16, "Alternatively or additionally...an audiovisual display."].

26. As for claim 4, Sitrick discloses the display control method according to claim 1, wherein a visual effect by which the extracted partial image can stereographically be seen is added in

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the step of adding the predetermined visual effect [col. 18, lines 39-46, “As mentioned elsewhere...of a joystick.”].

27. As for claim 5, Sitrick discloses the display control method according to claim 1, wherein a visual effect by which the extracted partial image can shinningly be seen is added in the step of adding the predetermined visual effect [Sitrick clearly anticipates modifications to the partial image, which would include altering the brightness, color and other aspects of the image.; col. 18, lines 16-30, “In accordance with...special graphics and audio data, etc.”].

28. As for claim 6, Ref discloses the display control method according to claim 1, further comprising the steps of:

displaying a predetermined game character [col. 25, lines 17-28, “The user created visual...set of game rules.”]; and

displaying the partial image together with the game character in a moving motion in response to operation for moving the game character [col. 25, lines 17-28, “The user created visual...set of game rules.”].

29. As for claim 11, Sitrick discloses a display control device comprising:

image capture means for capturing an image [video input source 330, Fig. 5A; col. 2, lines 50-64, “In accordance with one...system is coupled.”];

image extraction means for extracting a partial image from the image captured by the image capture means [col. 7, lines 36-40, “Game display functions...character image, etc.”]; col. 25, lines 5-16, “Alternatively or additionally...an audiovisual display.”];

visual effect addition means for adding a predetermined visual effect to the partial image extracted by the image extraction means [col. 25, lines 17-28, "The user created...of game rules."]; and

display means [display screen 340, Fig. 5A] for displaying the partial image in a moving motion added with the predetermined visual effect by the visual effect addition means [col. 22, lines 23-47, "For video game systems...video display presentation."; col. 25, lines 17-28, "The user created...of game rules."].

30. **Claims 1, 2, 4, 5 and 10-12** are rejected under 35 U.S.C. 102(e) as being anticipated by Kaji et al (US 6,183,367 B1) (hereinafter Kaji).

31. As for claims 1, 10 and 12, Kaji discloses a display control method and a storage medium having recorded therein a control program comprising the steps of:

capturing an image [col. 3, lines 10-19, "Desirably, the data...of the player."];

extracting a partial image from the captured image [col. 3, lines 33-37, "Moreover, desirably, the video...from the video data."];

adding a predetermined visual effect to the extracted partial image [col. 3, lines 27-32, "Moreover, the image display...can be changed."]; and

displaying the partial image added with the predetermined visual effect in a moving motion [col. 3, lines 38-41, "Furthermore, the image display...form of a window."].

32. As for claim 2, Kaji discloses the display control method according to claim 1, wherein a moving image is captured in the step of capturing the image [col. 3, lines 10-19, "Desirably, the data...of the player."]; and

the partial image is extracted using fixed parameters in the step of extracting the partial image [col. 3, lines 33-37, "Moreover, desirably, the video...from the video data."].

33. As for claim 4, Kaji discloses the display control method according to claim 1, wherein a visual effect by which the extracted partial image can stereographically be seen is added in the step of adding the predetermined visual effect [col. 1, lines 29-34, "In recent years...prescribed viewpoint."].

34. As for claim 5, Kaji discloses the display control method according to claim 1, wherein a visual effect by which the extracted partial image can shiningly be seen is added in the step of adding the predetermined visual effect [col. 3, lines 27-32, "Moreover, the image...can be changed."].

35. As for claim 11, Kaji discloses a display control device comprising:

image capture means for capturing an image [camera 33, Fig. 13];

image extraction means [video block, Fig. 13] for extracting a partial image from the image captured by the image capture means [col. 3, lines 33-37, "Moreover, desirably, the video...from the video data."];

visual effect addition [video block, Fig. 13] means for adding a predetermined visual effect to the partial image extracted by the image extraction means [col. 3, lines 27-32, "Moreover, the image display...can be changed."]; and

display means [monitor 34, Fig. 13] for displaying the partial image in a moving motion added with the predetermined visual effect by the visual effect addition means [col. 3, lines 38-41, "Furthermore, the image display...form of a window."].

***Claim Rejections - 35 USC § 103***

36. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

37. **Claims 7-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sitrick (US 5,553,864) as applied to claims 1 and 6, in view of Morhira (US 6,361,438 B1) (hereinafter Morhira).

38. As for claim 7, neither Sitrick nor Morhira specifically disclose a straight line passing the center of the entire captured image and displaying the partial image according to a predetermined timing moving along the straight line. However, Morhira presents a discussion of video game systems which model a three-dimensional space within which characters may interact [col. 1, lines 6-63, "The present invention...the translucent appearance."]. It is known and expected to those of ordinary skill in the gaming art that the characters, objects and images of the game may interact with a variety of other characters, objects and images, which may include straight lines and other geometric objects, depending on the particular game. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Sitrick and Morhira such that a straight line passes the center of the entire captured image and the partial image is displayed according to a predetermined timing moving along the straight line, because this would allow for creating a game effect where an object approaches or "attacks" an enemy, such as in the combat games disclosed by Morhira.

39. As for claim 8, Sitrick does not specifically disclose the display control method according to claim 7, wherein the partial image is displayed in a moving motion at a speed corresponded to the size of the partial image in the step for displaying the partial image in a moving motion along a straight line. Morhira teaches displaying an image in a moving motion at a speed corresponding to the size of the image [col. 1, lines 6-63, "The present invention...the translucent appearance."]. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Sitrick such that the partial image is displayed in a moving motion at a speed corresponded to the size of the partial image in the step for displaying the partial image in a moving motion along a straight line, because this would allow for creating a game effect where an object approaches or "attacks" an enemy with a three-dimensional perspective, such as in the combat games disclosed by Morhira.

40. As for claim 9, Sitrick discloses a display control method similar to claim 8, further comprising the steps of:

detecting contact between the partial image displayed in a moving motion along the straight line and the partial image in a moving motion which is displayed so as to pass the center of the entire image [col. 18, lines 16-30, "In accordance with....and audio data, etc."]; and

adding, upon detection of the contact between both partial images, a visual effect corresponded to the size of the partial image in a moving motion along the straight line to at least the partial image in a moving motion along the straight line [col. 18, lines 16-30, "In accordance with....and audio data, etc."].

***Conclusion***

41. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,254,477 B1, note controller of Fig. 7; US 5,595,389, note method for integrating partial images with video game; US 4,710,873, note col. 1; US 6,139,432, note possible 102(a) reference; US 5,984,780, note cols. 1-2; US 6,435,969 B1, note teaches changing brightness of captured image; US 6,283,858 B1, note method for image extraction and manipulation; US 6,120,379, note Fig. 1; US 6,335,731 B1, note Fig. 2, US 5,357,604, note graphics processor.
42. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron C Perez-Daple whose telephone number is (703)305-4897. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anil Khatri can be reached on (703)305-0282. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Aaron Perez-Daple



**ANIL KHATRI**  
**SUPERVISORY PATENT EXAMINER**